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3617

Attorney's Docket 200405.00024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of:

Inventors: Ilario Coslovi and James W. Forbes
Serial No: 09 / 650,388
Filed: August 29, 2000
Title: Vehicle Carrying Railroad Car And Bridge Plate Therefor
Assignee: National Steel Car
Art Unit: 3617
Examiner: Frantz F. Jules

REPLY TO EXAMINER'S ANSWER

to

APPLICANT'S APPEAL BRIEF

To: Mail Stop Appeal Brief- Patents
The Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Office Action of December 13, 2004 re-opening prosecution in view of the Appeal Brief filed October 19, 2004, on March 14, 2005, Applicants requested Reinstatement of Applicants' Appeal under 37 C.F.R. § 41.31 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the at least twice rejected claims 3 - 32 in the above-identified patent application.

The Applicants' Brief on Appeal was filed with the requisite filing fee under 37 C.F.R. § 41.20(b)(2). The Examiner's Answer was mailed on July 8, 2005. This Reply is filed in rebuttal of that Answer.

CERTIFICATION UNDER 37 C.F.R. § 1.8(a)

I hereby certify that, on the date shown below, this correspondence is being deposited with the United States Postal Service in an envelope with sufficient postage as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-13450.

Date: 9/7/05

Teri Naehring
Signature

Teri Naehring
(type or print name of person certifying)

This Reply contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37):

VII. Arguments

The other sections not included in this Reply are included in the Appeal Brief filed May 16, 2005 and are not repeated here. This Arguments included in this Reply are intended to supplement the Arguments included in the Appeal Brief filed May 16, 2005.

VII. Argument
Grouping of Claims

The claims under appeal include independent claims 3, 13, 20, 24 and 33 and dependent claims 4-10, 12, 14, 15, 18, 23, 26 and 28-32. The claims do not rise or fall together.

General Commentary: All Grounds of Traverse Repeated

Throughout this Reply, the Applicant continues to traverse all of the presently outstanding rejections, for the reasons stated in the Applicant's Brief on Appeal, which reasons are incorporated herein by reference. The Applicant intends not to recite those previous reasons at length, but rather to discuss only points raised, either explicitly or by omission, by the Examiner's Answer.

Rejections Under 35 U.S.C. §102 - Anticipation

Law of Anticipation

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Koehler, G.m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

Commentary on Rejections Under 35 U.S.C. §102: US Patent 5,782,187 of Black, Jr.

The Applicant respectfully submits that the Examiner's Answer does not respond to the Applicant's Arguments.

Examiner's Contention No. 1

The test for anticipation requires that the reference provide, either by illustrations or written description or both, an enabling description of the claimed invention. The present claims relate to bridge plates that span the gaps between the ends of two releasably coupled rail road cars. Given that fundamental premise, the Applicant believes that, with respect to the rejections under 35 USC 102, this Appeal can be decided in the Applicant's favour by asking two simple questions:

- (1) Is there, anywhere in Black, Jr., a drawing or description of the coupler end of *any* rail road car? Clearly not.
- (2) Is there, anywhere in Black, Jr., a drawing or description of a bridge plate mounted at the coupler end of *any* railroad car? Clearly not.

However, the Examiner points to Black Jr., col. 9, lines 45 – 50 as supporting the rejection. The Applicant respectfully disagrees. The rejections under 35 USC 102 have, from their inception in the Office Action of May 7, 2001 relied upon an incorrect interpretation of the Black Jr., reference. The point is that units **22a** and **22b** are units of the same single railroad car. This is exactly how Black defines them, at col. 4, lines 1 – 12:

“With initial reference to FIGS 1 and 2, the pivot plate assembly **20** is for use in spanning *a pair of pivotably interconnected units 22a and 22b of a vehicle-transporting railway car* at their pivotably interconnected ends **24a** and **24b** to stably support a vehicle **26** having a front portion **26a** and a rear portion **26b** straddling the articulation during transport as shown in Figure 1.” (Emphasis added).

The Applicant has repeatedly requested that the Examiner acknowledge the plainly evident fact that commentary provided in support of the rejection contradicts Black Jr., col. 4, lines 1 – 12. The Examiner has not ever addressed this point. There is nothing at col. 9, lines 45 – 50 that changes the definition provided at Col. 4, lines 1 – 12.

The bridge plates Black Jr., describes are internal bridge plates, not coupler end bridge plates. The commentary provided in the Office Action to support the current rejection simply contradicts what Black Jr., himself says, describes, and shows in his illustrations, e.g., Figures 1 and 2. Clearly, the Black reference does not, and never has, supported a rejection under 35 USC 102.

Second, the law prohibits the Examiner from making an interpretation of claim language inconsistent with the usage employed by the Applicant in the specification. (See: *Playtex Products Inc. v. Procter & Gamble Co.*, 400 F.3 901, 73 U.S.P.Q 2d 2010 (C.A.F.C. 2005), “A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.” *Merck & Co., Inc. v. Teva Pharm. USA, Inc.*, 347 F.3d 1367, 1370, 68 U.S.P.Q 2d, 1857 (C.A.F.C. 2003). (Emphasis added). See also, *Phillips v. AWH Corporation*, 415 F.3 1303, 75 U.S.P.Q. 2d 1321 (C.A.F.C. 2005))

The Applicant has clearly distinguished the internal ends of car units of an articulated rail road car from the coupler ends. See, for example, page 15, line 28 to page 16, line 8, and that portion of the present specification commencing at page 4, line 21 and including a lengthy discussion of couplers and draft gear extending to page 7, line 15. This distinction between unit ends at which there are permanent articulated connectors and ends at which there are releasable couplers is clear and consistent throughout the specification. Therefore, it is simply not in accord with US law for the Examiner to employ the incorrect interpretation of Black that is presently being employed to reject the claims.

Further Issues Not Addressed by Examiner's Answer

Examiner's Contention No. 2

Disengageable

Claim 3 is premised on the idea that the bridge plate can be disengaged from the coupler end of the second rail road car. There is nothing in Black, Jr., to show this ability in a manner sufficient to meet the requirements of a rejection under 35 USC 103, let alone a rejection under 35 USC 102.

Once again, the Examiner's Answer asserts that the structure shown by Black Jr., would be understood by persons skilled in the art as being “disengageable”. The rejection continues to ignore the fact that (a) there is clearly no support anywhere in the reference for a suggestion that the plates be taken apart; and (b) this requires the dis-assembly of the invention originally claimed by Black Jr., in the parent case of the cited reference (see US P 5,657,698, claims 3, 10, and 20, and all claims dependent therefrom, for example). It would be inherently contradictory for there to be a clear teaching in Black, Jr., to dismantle the very invention that Black teaches, and claims. A rejection that

relies on the making of a conjecture that the newly claimed invention can be obtained by deliberately dismantling part, or all, of the formerly described and claimed invention taught by the reference cannot be sound. First, it relies on conjecture; and second, it relies on a conscious disregard of the previous teaching. The Examiner's Answer does not address this point in any way.

Again, what appears to have been forgotten is that claim language is to be interpreted through the eyes of a person skilled in the art. Contrary to the requirements of *In re Lee*, 61 U.S.P.Q. 2d 1430, 277 F.3d 1338 (C.A.F.C. 2002), there has been no objective support provided in any of the Office Actions from May 7, 2001 to the present for the proposition that a person of ordinary skill in the art would regard Black's internal bridge plates as being "disengageable" within any reasonable meaning of the word.

On the contrary, the Examiner's Answer re-iterates the remarkable, and entirely unsupported, assertion that they are disengageable "*whenever needed*". This, itself, appears to ignore the underlying truth that Black's plates are shown in the context of a permanent articulated connection over a shared truck - the only structure actually shown or described by Black.

Location of Support in Reference Not Provided

The Applicant previously requested, if this ground of rejection were repeated, that there be a demonstration, by column and line number or by Figure and item number, where in the Black reference there is *any* indication (let alone a clear teaching as required) that the features identified by the Examiner are (a) intended to be taken apart after assembly; or (b) are intended to be dismantled as an ordinary incident of operation to permit plates 32 to be disengaged. No such demonstration has ever been provided.

The Coupler Ends

The Examiner's Answer again mistakes internal ends of body units of an articulated rail road car for coupler ends.

The terms coupler and coupler end are used consistently throughout the present specification, in clear distinction from rail road car body unit ends joined by permanent articulated connectors. That Black does not show coupler ends is abundantly clear. The only structure shown or described

by Black is that seen in side view in Figures 1 and 2. As such, a person skilled in the art might ask whether it is possible that the unit ends shown by Black are “coupler ends”. If that were so, then the purported rail road cars could be “uncoupled” at this connection. But it is obvious by inspection that any attempt to uncouple units **22a** and **22b** shown in Figures 1 and 2 would, on separation, leave at least one of the car unit ends without any support from the shared truck. Presumably it would then crash to the ground. The Applicant respectfully submits that any person skilled in the art would recognize this as unacceptable. Clearly, then, it does not require any particularly great insight to understand that the ends of units **22a** and **22b** shown by Black are not, and cannot be, reasonably construed as “coupler ends”. The Examiner's Answer does not address this issue, although it was clearly raised by the Applicant in the Brief on Appeal.

Examiner's Contention No. 3

Cross-wise Orientation

With respect to cross-wise orientation, the Examiner's Answer does not address the points raised by the Applicant.

Whether or not Black's apparatus includes polymeric sleeve **111**, the issue is not whether Black's internal bridge plates can accommodate yaw during operation.

The issue is (a) whether Black's internal bridge plates are coupler end bridge plates (which they are not); and, if they were, (b) whether they can be moved to a cross-wise position.

The Applicant has specifically, and repeatedly, raised the issue of the relationship of deck **44**, platforms **30**, plates **32**, and wear bars **110**, **112** and **114**, which appears to preclude movement to a cross-wise orientation. The Examiner's Answer appears to ignore this. Given that there is no response to this point in the “Examiner's Answer”, the Applicant respectfully submits that it is entitled to a favourable resolution on this point by default: Black, Jr. does not show or describe bridge plates that are movable to a cross-wise position.

The UMLER

The key concept that does not seem to have been understood by the Examiner throughout this prosecution is that Black's Figures illustrate portions of a single articulated rail road car. A rejection under 35 USC 102 cannot be made on the basis of something that the reference neither shows nor

describes, namely a bridge plate operated between two railroad cars releasably coupled together.

To make this point clear, the Applicant has discussed the UMLER classification system used universally throughout the railroad industry in North America. The "Examiner's Answer" does not address the UMLER in any way. The Applicant respectfully submits that on this point alone the Applicant is entitled to a favourable resolution of this matter by default.

Claim Rejections Under 35 U.S.C. §103

Statement of the Law

Again, in the interest of brevity, the Applicant repeats by reference the commentary made in the Appeal Brief with respect to rejections made under 35 USC 103.

Claim Rejections Under 35 U.S.C. §103: Claim 8

US Patent 5,782,187 of Black, Jr. and US Patent 5,836,028 of Petersen

The Applicant notes that there is nothing in the Examiner's Answer referring to the Applicant's commentary with respect to the Petersen reference. The Applicant therefore respectfully requests favourable resolution of this issue by default.

US Patent 4,721,426 of Bell

The Examiner's Answer, Section 10, Grounds of Rejection, paragraph 4, page 4, once again mentions the Bell reference in the context of rejections of claims 8, 12, 18 and 28. This is surprising for a number of reasons:

- (1) The Applicant understood that there were no outstanding rejections currently relying upon the Bell reference;
- (2) The Applicant understood that the Commissioner had conceded that the grounds for which Bell had been cited were not supported by the reference itself;
- (3) The Applicant did not discuss the Bell reference in the Appeal Brief (not surprisingly, given that it is no longer relied upon by the Commissioner as providing a basis for any current rejection); and

- (4) Bell is not listed in Section 9, Prior Art of Record of the Examiner's Answer
- (5) The rejection based on Bell is not identified as a new grounds of rejection in the Examiner's Answer

Applicant assumes the reference to Bell in the Examiner's Answer was inadvertent in that Bell was addressed in earlier prosecution and subsequently removed as a reference applied against the claims in this application. If the Examiner is intending to use Bell as a reference in the rejection of these claims, Applicant requests that the Examiner identify this a new grounds of rejection and that applicant be given the opportunity to address Bell in a further Reply

Examiner's Contentions Nos. 4, 5 and 6

Claim Rejections Under 35 U.S.C. §103: Claims 12, 18 and 28

US Patent 5,782,187 of Black, Jr., and US Patent 3,195,478 of Thompson

The Applicant repeats, by reference, the commentary previously made in the Applicant's Brief on Appeal with respect to the Thomson reference.

Statements of The Law and Application of the Law

Previous Office Actions in this matter have contained assertions of law that appear to have been without foundation in the statute, the regulations, or the case law. Indeed, the Applicant respectfully submitted that some of the statements were either incomprehensible, or directly contrary to the law. Since correct application of the law is fundamental to the examining process, the Applicant has respectfully, explicitly, and repeatedly requested specific clarification of those points.

Inasmuch as the Examiner's Answer does not address these issues in any way, the Applicant respectfully submits that the "Examiner's Answer" is a deemed admission that the law has repeatedly and consistently been improperly applied in making rejections in this matter. The Applicant therefore requests that the Board hold that, in default of an Answer by the Examiner, the Applicant is entitled to resolution in the Applicant's favour of all outstanding issues pending in this appeal.

Oral Hearing Not Requested

The Applicant does not request an oral hearing of this Appeal.

Conclusion

In view of the foregoing arguments, the applicant submits that claims 3 - 46 presently pending in this case are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

Respectfully submitted,



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